

REMARKS

Applicant has considered all points made by the examining attorney in the Notice of Non-Compliant Amendment mailed January 4, 2006 in response to Applicant's Response to Office Action Dated July 12, 2005. Applicant also has considered, and responds, to all points made by the examining attorney in the Office Action mailed July 12, 2005.

1. Non-Compliant Amendment.

The examining attorney has stated that had the claims 5-8 added in Response to the July 12, 2005 Office Action been presented prior to the initial examination of the application, a restriction would have been issued from the applicant to elect a single invention. The examining attorney invited the Application to file an amendment to the instant application within the scope of the original presentation or file a divisional application to claim the new invention.

Applicant has chosen to take both courses of action. On February 3, 2006, Applicant filed U.S. Patent Application Serial No. 11/346,933 with the United States Patent and Trademark Office claiming the invention as embodied in claims 5-8.

In the instant response, Applicant has cancelled claims 5-8 and added new claims 9-14. Claims 9 and 10 are virtually verbatim copies of the original claims 1 and 2. The only differences in the claims being the addition of the word "all" to claim 9 such that wherein original claim 1 read "displaying said potential relationship data upon said terminals for review by said members", new claim 9 reads "displaying said potential relationship data upon said terminals for review by **all** said members" and amendment in response to the claim objection asserted by the examining attorney in his July 12, 2005 Office Action.

Applicant will respond to all points raised by the examining attorney with respect to the original claims below.

2. Claim Objections.

The examining attorney objected to original claims 1 and 3 stating that the limitation "preparing said computer system ..." is not clearly defined in the disclosure as originally filed. Claim 1, as amended from the original filing, is now embodied in claim 9. The phrase "preparing

said computer system” of original claim 1 has been amended to read “actuating said computer system” in new claim 9. Original claim 3 has been cancelled with no counterpart in the new claims. No new matter has been added.

3. Claim Rejections Under 35 USC § 103.

Original claims 1 – 4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Horwitz et al. (U.S. Patent No. 5,774,866). Original claims 3 and 4 have been cancelled. Although original claims 1 and 2 have also been cancelled, they are substantially identically embodied in new claims 9 and 10. Applicant respectfully traverses these rejections

Horwitz does not teach all of the claim limitations of Applicant’s invention. “To establish a prima facie case of obviousness ... the prior art reference (or references when combined) must teach or suggest all the claim limitations.” M.P.E.P. § 2143; *see In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

In particular, Horwitz lacks disclosure of two important elements of Applicant’s invention. First, the method of Horwitz does not involve all the members of an organization in the identification of potential conflicts. That is, information regarding the potential new client/matter is shared only with a limited subset of members of the organization. (Horwitz, Col. 17, Lines 46-48, and Col. 20, Lines 44-53). In contrast, Applicant’s invention transmits and displays information about potential new clients/matters to every member of the organization. The import of this distinction will be discussed in greater detail below.

The second distinction between the Horwitz reference and Applicant’s invention is that, in the Horwitz reference, conflicts are only checked against current clients/matters which are represented within the databases of the organization. The Horwitz reference extracts key words from the names of the potential party and compares those key words against the names of existing clients/parties stored in a database. (Horwitz, Col. 18, Lines 34-43). Only after potential conflicts with existing clients/parties are identified by the computer using the key word search is conflict information transmitted to a human user; and then only to those people assigned to the existing matter. (Horwitz, Col. 20, Lines 44-53).

These two differences interact with one another to create two fatal shortcomings of the Horwitz reference. First, by flagging and transmitting only those conflicts the computer found in the organization's database system, Horwitz lacks the ability to locate potential or real conflicts with clients/matters which are, for some reason, not yet stored within the organization's database system. For example, in a law office, suppose attorney Able is courting a non-client party to a dispute. Unknown to attorney Able, attorney Baker is courting the other party to the same dispute and that party is also not a client. Both Able and Baker will enter the respective parties into the potential conflict table but, under Horwitz, neither will learn about the other's activities because neither of the parties to the dispute are currently clients. Each attorney will believe that there are no potential or real conflicts existing and each may attempt to retain the opposing parties to the dispute.

Another failure of the Horwitz reference which is addressed by the Applicant's introduction of humans into the process is that Horwitz lacks the ability to identify soft conflicts. A soft conflict is a situation wherein the retention of the potential client, while not conflicting with an existing client, would create displeasure with an existing client. For example, many clients are not happy when their law firm also represents their chief competitors. The Horwitz reference discloses no method of identifying these conflicts.

Indeed, not only does the Horwitz reference fail to disclose the transmission of potential conflict information to all members of an organization, the reference teaches away from that element. Horwitz states that "[m]ost preferably, each person within the organization receives potential conflict signals **relating only to those potential conflicts involving existing parties for whom such person is responsible.**" (Horwitz, Col. 4, Lines 12-16) (emphasis added).

Because Horwitz does not teach or suggest all of the limitations of Applicant's invention and, in fact, teaches away from those limitations, the Horwitz reference cannot render Applicant's invention obvious. Therefore, the Applicant respectfully requests withdrawal of the rejections based upon the Horwitz reference.

CONCLUSION

At this time and in view of Applicant's amendments and arguments set forth above, it is respectfully submitted that all pending claims are allowable, and a Notice of Allowance is respectfully requested.

Respectfully submitted,
JACKSON WALKER L.L.P.

A handwritten signature in black ink, appearing to read "William Nash", written in a cursive style.

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